

REMARKS

Reconsideration of the subject application in light of the following remarks, pursuant to and consistent with 37 C.F.R. § 1.116, are thus respectfully requested.

1. Status of the Claims

Claims 1, 3-9, 11, 14, and 16-20 stand pending and rejected. Claims 2, 10, 12-13, 15, and 21-23 stand previously canceled.

2. Acknowledgement of Information Disclosure Statement

Applicants appreciate the Office's acknowledgement of the Information Disclosure Statement filed May 25, 2007.

3. Withdrawn Objections and Rejections

Rejections and objections not reiterated are withdrawn. *See* 37 C.F.R. § 1.113(b); M.P.E.P. §§ 706.07 and 707.07(e).

4. Rejection Under 35 U.S.C. § 102(b)

The Office maintains the rejection of claims 1, 3-6, 9, and 19-20 under 35 U.S.C. § 102(b) as allegedly anticipated by **Carbomb** from the Webtender ("Carbomb"), as evidenced by **Guinness** from the Greens Beverages ("Guinness"); **Jameson's Irish Whiskey** from the Drinkmixer ("Jameson's Whiskey"); **Guinness Stout** from the Drinkmixer ("Guinness Stout"); and **Bailey's Irish Cream** from the Drinkmixer ("Bailey's Irish Cream").

Claim 1 recites "*a ratio between an alcohol content from the alcohol-containing material of the component A and an alcohol content from the alcohol-containing distillate of the component B*" ("alcohol content ratio") in the range of about 97.5:2.5 to about 90:10. The Office alleges that Carbomb discloses the claimed alcohol content ratio, because a ratio of the alcohol content of components is 9.75:1 (as Whiskey : Beer = 40%/4.1%). Office Action, page 3, ¶ 8. The Office further alleges that (1) even though Applicants' prior interpretation of the claimed alcohol content ratio is possible, "the claims do not necessarily limit the claims to the

applicant's interpretation"; and (2) the claimed alcohol content ratio is not defined by the Specification. *Id.*, at 9, ¶ 12.

Applicants traverse. First, the Office misconstrues the claimed alcohol content ratio. The Office is respectfully reminded that the interpretation of a claim element must be ***consistent with the specification***. See *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1259, 94 U.S.P.Q.2d 1640, 1643 (Fed. Cir. 2010) (dismissing the Board's claim interpretation as unreasonable and remanding, because the Board's interpretation was inconsistent with the specification).

The Office's formula to calculate the claimed ratio is unsupported. Claim 1 recites the alcohol content ratio as "a ratio between an alcohol content ***from*** ... the component A and an alcohol content ***from*** ... the component B." By its plain language, the claimed alcohol content ratio is calculated based on the alcohol content ***from*** each component. A skilled artisan would have understood that the claimed ratio takes into account of the volume factors as in the following Formula I:

$$C_A V_A : C_B V_B \quad \text{[Formula I]}$$

wherein *C* represents the alcohol content of a component, and *V* represents the volume of the component.

In contrast, the Office insists that the calculation should only consider the alcohol content ***of*** each component. Second, a skilled artisan would have understood that "a ratio between X and Y" refers to "X/Y," where X is the nominator and Y is the denominator. The Office, however, maintains that switching the numerator and denominator in the calculation is permissible.

Furthermore, the Office's interpretation of the claim alcohol content ratio is inconsistent with the Specification. The Office is respectfully directed to the Substitute Specification, Table 1, ¶ [0036]:

[0036]

Table 1

| | Inventive Product | | | | | Comparative Ex. | |
|-----------------------------------------------------------------|-------------------|------|-----|-----|-----|-----------------|-----|
| | 1 | 2 | 3 | 4 | 5 | 1 | 2 |
| Ratio between alcohol content from A and alcohol content from B | | | | | | | |
| From A | 99 | 97.5 | 95 | 90 | 80 | | |
| From B | 1 | 2.5 | 5 | 10 | 20 | | |
| Results of taste sensory test | | | | | | | |
| Robust feel | 4.8 | 4.8 | 4.8 | 3.9 | 2.9 | 4.9 | 1.2 |
| Crispness | 3.0 | 4.1 | 4.4 | 4.1 | 4.3 | 2.4 | 4.4 |

As described in Example 1, ¶¶ [0035]-[0039] of the Substitute Specification, Applicants obtain Inventive Products 1-5 by mixing various proportions of component A (a beer) and component B (a mugi shochu). Table 1 indicates that Inventive Products 1-5 have various “ratios between alcohol content from A and alcohol content from B” (99:1, 97.5:2.5, 95:5, 90:10, and 80:20). A skilled artisan, by reading the plain language of “ratio between alcohol content *from* A and alcohol content *from* B” of Table 1 and Example 1 of the Specification, would have agreed with Formula I presented above. According to Office’s calculation of the alcohol content ratio, Table 1 would have yielded a *single* ratio, 90:10 (44%:5%), because the beer and the mugi shochu of Example 1 have alcohol contents of 5% and 44%, respectively. The Office’s calculation is thus inconsistent with the present Specification. Accordingly, the Office’s interpretation of the claimed alcohol content ratio is unsupported.

Based on the above Formula I, Carbomb would give an alcohol content ratio (Guinness : Whiskey) of about 57.1:42.9 to about 58.9:41.1 ($C_A V_A : C_B V_B$: $4.1\% \times 13 \text{ oz} : 40\% \times 1 \text{ oz} = \mathbf{57.1:42.9}$, and $4.1\% \times 14 \text{ oz} : 40\% \times 1 \text{ oz} = \mathbf{58.9:41.1}$). This range is outside the claimed range of claim 1, *i.e.*, about 97.5:2.5 to about 90:10. The cited references thus fail to disclose, explicitly or inherently, at least the claimed alcohol content ratio. *See In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993) (holding that prior art that anticipates a claim must disclose each and every element of the claim explicitly or inherently).

Claim 1 is thus novel over cited references. Dependent claims 3-6, 9, and 19-20 are likewise novel over cited references. Accordingly, Applicants respectfully request withdrawal of the rejection and allowance of the claims.

5. Rejections Under 35 U.S.C. § 103(a)

5.1. Rejection of Claims 1, 3-6, 9, 11, 14, 16, and 19-20

The Office maintains the rejection of claims 1-6, 9, 11-16, and 19-20 under 35 U.S.C. § 103(a) as allegedly obvious over **Hoppy de Happy-to** in view of either **Shinozaki** (JP 60241883) (“Shinozaki”) or **Japan Alcoholic Beverages** from the Global Gourmet (“Japan Alcoholic Beverages”), as evidenced by **Japan - Taxes on Alcoholic Beverage** from the World Trade Organization (“Japan – Taxes”). Office Action, pages 5-7, ¶ 10. The Office alleges that Hoppy de Happy-to teaches an alcohol content ratio of either 31.25 (shochu : Hoppy = 0.25/0.008) or 15.625 (shochu : Hoppy = 0.125/0.008). *Id.*, at 6.

Applicants traverse. The Office is reminded that “obviousness requires a suggestion of *all* limitations in a claim.” *CFMT, Inc. v. Yieldup Int’l Corp.*, 349 F.3d 1333, 1342, 68 U.S.P.Q.2d 1940, 1947 (Fed. Cir. 2003) (emphasis added). Once the scope and content of the prior art are determined, the relevant inquiry is whether the prior art suggests the invention, and whether one of ordinary skill in the art would have had a reasonable expectation that the claimed invention would be successful. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991).

First, the Office misconstrues the claimed alcohol content ratio. As discussed in Section 4 *supra*, the Office’s formula of the claimed alcohol content ratio is unsupported, because the Office’s calculation (1) fails to take into account the volume factor, and (2) switches the numerator and denominator. Based on the Formula I described in Section 4 *supra*, the mixed beverage of Hoppy de Happy-to would give an alcohol content ratio (Hoppy : shochu) of about 7.0:93.0 to about 24.2:75.8.¹ This range is outside the claimed range of claim 1. The secondary references Shinozaki and Japan Alcoholic Beverages, as well as the supporting reference Japan – Taxes on Alcoholic Beverage, do not teach or suggest an alcohol content ratio within the claimed range. The cited references, alone or viewed in combination, thus fail to teach or suggest at least

¹ For the mixed beverage with an alcohol content of 3%, the volume ratio would be **90.9:9.1** (Hoppy : shochu), because $90.9\% \times 0.8\% + 9.1\% \times 25\% = 3\%$. The corresponding alcohol content ratio would be $(90.9\% \times 0.8\%) : (9.1\% \times 25\%) = \mathbf{21.7:78.3}$ (Hoppy : shochu). For the mixed beverage with an alcohol content of 8%, the volume ratio would be **90.9:9.1** (Hoppy : shochu), because $70.2\% \times 0.8\% + 29.8\% \times 25\% = 8\%$. The corresponding alcohol content ratio would be $(70.2\% \times 0.8\%) : (29.8\% \times 25\%) = \mathbf{7.0:93.0}$ (Hoppy : shochu).

the claimed alcohol content ratio. No change in ratio or instruction is provided of teaching a combination that would achieve the desired taste of the presently claimed product. Without all claim elements taught, there further cannot be an expectation to make or use the claimed product, let alone an expectation that such a product would have been successful. Accordingly, claim 1 is nonobvious over cited references.

Furthermore, Applicants have discovered for the *first time* that mixing component A and component B with the recited ratio results in a beverage with refreshing finish, *i.e.*, crisp taste while ensuring robust feel. See Substitute Specification, pages 2-3, ¶¶ [0007]-[0008], and page 12, ¶ [0033]. The Office is further directed to page 13, Table 1 of the Substitute Specification (Table 1 is presented in Section 4 *supra*). Applicants observe crisp taste while ensuring robust feel for Inventive Products 2-4, which have the alcohol content ratios of 97.5:2.5, 95:5, and 90:10, respectively.² Accordingly, both crispness and robust feel occur over the entire claimed range. At best, Hoppy de Happy-to teaches a “mellow feeling” for the mixture of Hoppy and shochu. See the English translation of Hoppy de Happy-to (kindly provided by the Office), the full paragraph on page 5. The “mellow feeling” is neither a crisp taste nor a robust feel. There is no suggestion in any of the references on how to achieve either a crisp taste or a robust feel. Therefore, there is no guidance, let alone expectation of success, to alter the ratio in order to achieve this result. The claimed beverage thus possesses *unexpected*, advantageous properties.

In view of above arguments, claim 1 stands nonobvious over cited references. Dependent claims 3-6, 9, 11, 14, 16, and 19-20 are likewise nonobvious. Accordingly, Applicants respectfully request withdrawal of the rejection and allowance of the claims.

5.2. Rejection of Claims 7-8

The Office maintains the rejection of claims 7-8 under 35 U.S.C. § 103(a) as allegedly obvious over unpatentable over **Carbomb**, as evidenced by **Guinness**, **Jameson's Whiskey**, **Guinness Stout**, and **Bailey's Irish Cream**, and further in view of **Tripp** et al. (U.S. Patent No. 5,618,572) (“Tripp”). Office Action, pages 4-5, ¶ 9.

² Inventive Products 2-4 have robust feel scores of 3.9 or greater and crispness scores of 4.1 or greater. A taste score of 4 is set as “Strong,” while a taste score of 3 is set as “Normal.” See Substitute Specification, page 14, ¶ [0038].

Applicants traverse. Both claims 7-8 recite the claimed alcohol ratio element because of their dependency from claim 1. As discussed in section 4 *supra*, Carbomb (together with Guinness, Jameson's Whiskey, Guinness Stout, and Bailey's Irish Cream) fail to teach at least the claimed alcohol content ratio element of claim 1. Tripp fails to teach the claimed ratio element. At best, Tripp purportedly teaches that (1) the malt proportion may range from 26 to 127% (malt/dextrose), and (2) a 80-100% pale malt beer may be used as a feed beer. Therefore, Tripp fails to cure the defects of the other references. The cited references, when viewed alone or in combination, fail to teach at least the claimed ratio element of each of claims 7-8. Without all claim elements taught, there cannot be expectation to make or use the claimed product.

Accordingly, claims 7-8 are nonobvious over the cited references. Applicants respectfully request withdrawal of the rejection and allowance of the claims.

5.3. Rejection of Claims 7-8 and 17-18

The Office maintains the rejection of claims 7-8 and 17-18 under 35 U.S.C. § 103(a) as allegedly obvious over **Hoppy de Happy-to** in view of either **Shinozaki** or **Japan Alcoholic Beverages**, as evidenced by **Japan – Taxes**, and further in view of **Tripp**. Office Action, pages 7-9, ¶ 11.

Applicants traverse. Claims 7-8 and 17-18 recite the claimed alcohol content ratio because of their dependency from claim 1. As discussed in section 5.1 *supra*, Hoppy de Happy-to, Shinozaki, Japan Alcoholic Beverages, and Japan – Taxes fail to teach at least the claimed ratio element of claim 1. Tripp also fails to teach the claimed ratio element. At best, Tripp purportedly teaches that (1) malt proportion may range from 26 to 127% (malt/dextrose), and (2) a 80-100% pale malt beer may be used as a feed beer. Therefore, Tripp fails to cure the defects of the other references. The cited references, when viewed alone or in combination, fail to teach at least the claimed ratio element of each of claims 7-8 and 17-18. Without all claim elements taught, there cannot be an expectation to make or use the claimed product, let alone an expectation that the product would have been successful.

In view of the above arguments, claims 7-8 and 17-18 are nonobvious, because cited references fail to teach at least the claimed ratio element. Accordingly, Applicants respectfully request withdrawal of the rejection and allowance of the claims.

CONCLUSION

In view of the above arguments and amendments to the claims, Applicants submit that the claims are in condition for allowance and respectfully request reconsideration and timely allowance of the claims.

Should the Office have any questions or comments regarding Applicants' amendments or response, please contact Applicants' undersigned representative at (202) 842-8821. Furthermore, please direct all correspondence to the below-listed address.

In the event that the Office believes that there are fees outstanding in the above-referenced matter and for purposes of maintaining pendency of the application, or for Notice of Appeal, the Office is authorized to charge the outstanding fees to Deposit Account No. 50-0573. The Office is likewise authorized to credit any overpayment to the same Deposit Account Number.

Respectfully Submitted,

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